



Docket No. 45858/55672

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Goldsborough, et al.

EXAMINER: B. Sisson

SERIAL NO. 09/725,897

GROUP ART UNIT: 1634


FILED: November 30, 2000

FOR: METHODS FOR THE STORAGE AND SYNTHESIS OF  
NUCLEIC ACIDS USING A SOLID SUPPORT

\*\*\*\*\*

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: RCE, Commissioner for Patents, P.O. Box, Alexandria, VA 22313-1450 on April 30, 2004.

By:   
Sharon Bizokas

\*\*\*\*\*

Mail Stop: RCE  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

STATEMENT THAT SUBSTITUTE SPECIFICATION  
CONTAINS NO NEW MATTER (37 C.F.R. SECTION 1.125)

**1. Identification of person making this statement**

Kathryn A. Piffat, Ph.D. (Reg No. 34,901)  
Intellectual Property Practice Group of  
Edwards & Angell, LLP  
PO Box 55874  
Boston, MA 02205

The person making this statement is:

*(complete applicable item)*

- ☐ the inventor in this application.  
☒ the attorney in this application, Registration Number 34,901.  
☐ other *(indicate relationship)*

Docket No. 45858/55672  
APPLICANT: Goldsborough, et al  
SERIAL NO. 09/725,897  
FILED: November 30, 2000

## 2. Statement

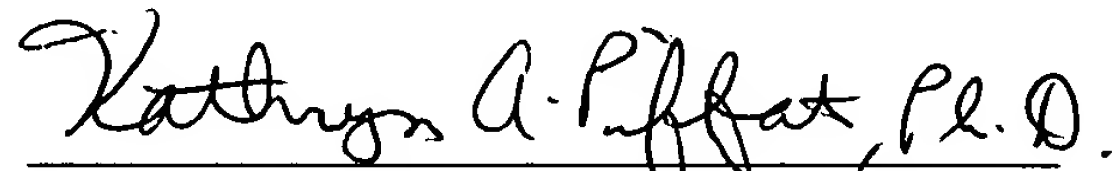
I hereby state that the accompanying substitute specification contains no new matter over that contained in the above-identified application originally filed.

*(complete the following, if applicable)*

☒ I further state that the changes made are the same as indicated in the inter-lineated original specification also accompanying this declaration.

Respectfully submitted,

Date: April 30, 2004



Kathryn A. Piffat, Ph.D., Reg No. 34,901  
Intellectual Property Practice Group of  
Edwards & Angell, LLP  
P.O. Box 55874  
Boston, MA 02205  
Tel.: 617.439.4444

Customer No.: 21874

BOS2\_443063.1



Docket No. 45858/55672

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Goldsborough, et al.

EXAMINER: B. Sisson

SERIAL NO. 09/725,897

GROUP ART UNIT: 1634

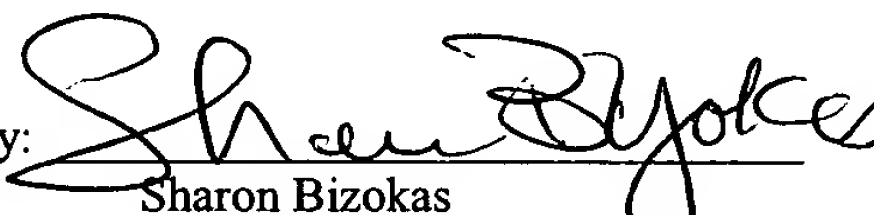
FILED: November 30, 2000

FOR: METHODS FOR THE STORAGE AND SYNTHESIS OF  
NUCLEIC ACIDS USING A SOLID SUPPORT

\*\*\*\*\*

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 30, 2004.

By:   
Sharon Bizokas

\*\*\*\*\*

Mail Stop: RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUBMISSION OF "SEQUENCE LISTING," COMPUTER READABLE COPY,  
AND/OR AMENDMENT PERTAINING THERETO  
FOR BIOTECHNOLOGY INVENTION CONTAINING NUCLEOTIDE  
AND/OR AMINO ACID SEQUENCE**

*(check and complete this item, if applicable)*

1. ☒ This replies to the Office Letter DATED October 31, 2003.

☐ A copy of the Office Letter is enclosed.

**IDENTIFICATION OF PERSON MAKING STATEMENT**

2. I, Kathryn A. Piffat, Ph.D.  
*(type or print name of person signing below)*

state the following:

**ITEMS BEING SUBMITTED**

3. Submitted herewith is/are:

*(check each item as applicable)*

- A. ☒ "Sequence Listing(s)" for the nucleotide and/or amino acid sequence(s) in this application. Each "Sequence Listing" is assigned a separate identifier as required in 37 C.F.R. Section 1.821(c) and 37 C.F.R. Sections 1.822 and 1.823.
- B. ☒ An amendment to the description and/or claims, wherein reference is made to the sequence by use of the assigned identifier, as required in 37 C.F.R. Section 1.821(d).
- C. ☒ A copy of each "Sequence Listing" submitted for this application in computer readable form, in accordance with the requirements of 37 C.F.R. Sections 1.821(e) and 1.824.
- D. ☐ Please transfer to this application, in accordance with 37 C.F.R. Section 1.821(e), the computer readable copy(ies) from applicant's other application identified as follows:

In re application of:

Application No.: 0 /

Filed:

For:

Group No.:

Examiner:

The Computer readable form(s) of applicant's other application corresponds to the "Sequence Identifier(s)" of the application as follows:

Computer Readable Form

(other application)

"Sequence Identifier"

(this application)

*NOTE: "If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference maybe made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application. The new application shall be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified." 37 C.F.R. Section 1.821(e).*

- E. ☒ A statement that the content of each "Sequence Listing" submitted and each computer readable copy are the same, as required in 37 C.F.R. Section 1.821(g).
- ☐ Because the statement is not made by a person registered to practice before the Office, the Statement is verified as required in 37 C.F.R. Section 1.821(b).

F. ☒ Because this submission is made in fulfilling the requirement under 37 C.F.R. Section 1.821(g), a statement that the submission includes no new matter.

☐ Because the statement is not made by a person registered to practice before the Office, the statement is verified, as required in 37 C.F.R. Section 1.821(g).

**STATEMENT THAT "SEQUENCE LISTING"  
AND COMPUTER READABLE COPY ARE THE SAME  
AND/OR THAT PAPERS SUBMITTED INCLUDES NO NEW MATTER**

4. I hereby state:

*(complete applicable item A and/or B)*

A. ☒ Each computer readable form submitted in this application, including those forms requested to be transferred from applicant's other application, is the same as the "Sequence Listing" to which it is indicated to relate.

B. ☒ All papers accompanying this submission, or for which a request for transfer from applicants' other application, introduce no new matter.

**STATUS**

5. Applicant is

☐ a small entity.

☒ other than a small entity.

**EXTENSION OF TERM**

6.

*NOTE: "Extension of Time in Patent Cases (Supplement Amendments) If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.*

*If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of Dec.10, 1985 (1061 O.G. 34-35).*

*NOTE: See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.*

7. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply.

*(complete (a) or (b) as applicable)*

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. Section 1.136 (fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

| Extension<br>(months)                            | Fee for other than<br>small entity | Fee for<br>small entity |
|--------------------------------------------------|------------------------------------|-------------------------|
| <input type="checkbox"/> one month               | \$ 110.00                          | \$ 55.00                |
| <input type="checkbox"/> two months              | \$ 420.00                          | \$ 210.00               |
| <input checked="" type="checkbox"/> three months | \$ 950.00                          | \$ 475.00               |
| <input type="checkbox"/> four months             | \$1,480.00                         | \$ 740.00               |

**Fee \$ 950.00**

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured, and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

**OR**

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

**FEE PAYMENT**

8. ☒ Attached are checks in the sum of \$950.00 and \$770.00 (extension fee and RCE fees)

- ☐ Charge Account No. \_\_\_\_\_ the sum of \$ \_\_\_\_\_.  
A duplicate of this transmittal is attached.

**FEE DEFICIENCY**

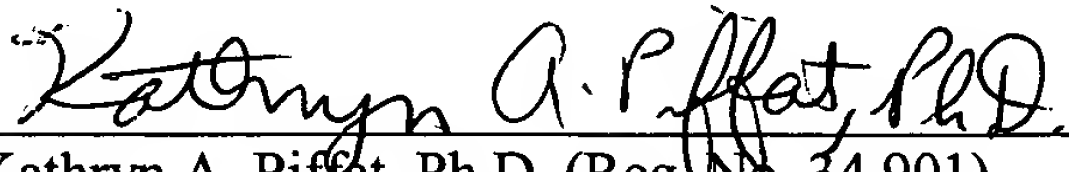
9.

*NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.*

10. [X] If any additional extension and/or fee is required, charge Account No. 04-1105 .

Respectfully submitted,

Date: April 30, 2004

  
Kathryn A. Piffat, Ph.D. (Reg. No. 34,901)  
Intellectual Property Practice Group of  
EDWARDS & ANGELL, LLP  
P.O. Box 55874  
Boston, MA 02205  
(617) 439-4444

Customer No. 21874

BOS2\_443060.1



Docket No. 45858/55672

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Goldsborough, et al.

EXAMINER: B. Sisson

SERIAL NO. 09/725,897

GROUP ART UNIT: 1634

FILED: November 30, 2000

FOR: METHODS FOR THE STORAGE AND SYNTHESIS OF  
NUCLEIC ACIDS USING A SOLID SUPPORT

\*\*\*\*\*

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 30, 2004.

By:   
Sharon Bizokas

\*\*\*\*\*

Mail Stop: RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Transmitted herewith for filing in the above-referenced patent application are the following documents:

1. Request for Continued Examination (6 pages);
2. Amendment Transmittal (4 pages);
3. Amendment (25 pages);
4. Substitute Specification (marked) (109 pages);
5. Substitute Specification (unmarked) (107 pages);
6. Statement (Substitute Specification) (2 pages);
7. Submission of Sequence Listing (5 pages);
8. Statement of Sequence Listing Provider (1 page);
9. Paper Copy of Sequence Listing (4 pages);
10. Diskette Containing Sequence Listing;
11. Checks in the amount of \$770.00 (RCE fee) & \$950.00 (extension fee);
12. This Transmittal letter (2 pages) (x2); and
13. Return Receipt Postcard

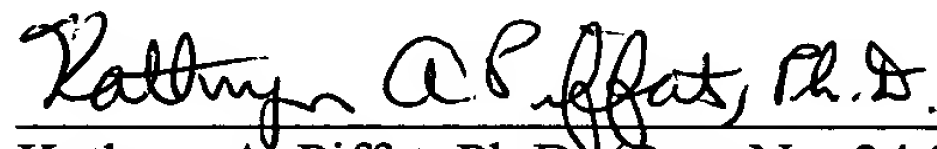


Docket No. 45858/55672  
APPLICANT: Goldsborough, et al  
SERIAL NO. 09/725,897  
FILED: November 30, 2000

The Commissioner is hereby authorized to charge any excess fees that may be required, or credit any overpayment to Deposit Account No. 04-1105. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Date: April 30, 2004



Kathryn A. Piffat, Ph.D. (Reg. No. 34,901)  
Intellectual Property Practice Group of  
EDWARDS & ANGELL, LLP  
P.O. Box 55874  
Boston, MA 02205  
(617) 439-4444

Customer No. 21874



Docket No. 45858/55672

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Goldsborough, et al.

EXAMINER: B. Sisson

SERIAL NO. 09/725,897

GROUP ART UNIT: 1634

FILED November 30, 2000

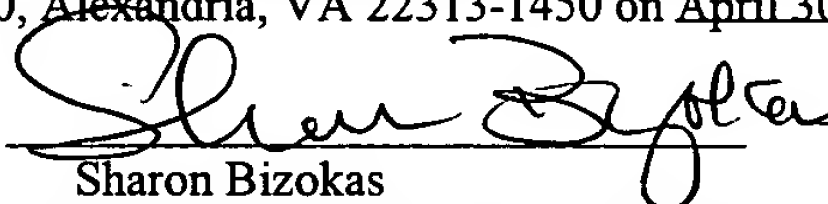
FOR: METHODS FOR THE STORAGE AND SYNTHESIS OF  
NUCLEIC ACIDS USING A SOLID SUPPORT

\*\*\*\*\*

**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop: RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 30, 2004.

By:

  
Sharon Bizokas

\*\*\*\*\*

Mail Stop: RCE  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT TRANSMITTAL**

1. Transmitted herewith is a Request for Reconsideration for this application.

**STATUS**

2. Applicant is  
☐ a small entity. A statement:  
☐ is attached.  
☐ was already filed.  
☒ other than a small entity.

**EXTENSION OF TERM**

**NOTE:** "Extension of Time in Patent Cases (Supplement Amendments) -- If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Office Action, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period has ceased to run." Notice of December 10, 1985 (1061 O.G. 34-35).

Docket No. 45858/55672  
APPLICANT: Goldsborough, et al  
SERIAL NO. 09/725,897  
FILED: November 30, 2000

NOTE: See 37 C.F.R. Section 1.645 for extensions of time in interference proceedings, and 37 C.F.R. Section 1.550(c) for extensions of time in reexamination proceedings.

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. Section 1.136 apply.

*(complete (a) or (b), as applicable)*

- (a) ☒ Applicant petitions for an extension of time under 37 C.F.R. Section 1.136 (fees: 37 C.F.R. Section 1.17(a)(1)-(4)) for the total number of months checked below:

|                                     | Extension<br>(months) | Fee for other than<br>small entity | Fee for<br>small entity |
|-------------------------------------|-----------------------|------------------------------------|-------------------------|
| <input type="checkbox"/>            | one month             | \$ 110.00                          | \$ 55.00                |
| <input type="checkbox"/>            | two months            | \$ 420.00                          | \$ 210.00               |
| <input checked="" type="checkbox"/> | three months          | \$ 950.00                          | \$ 475.00               |
| <input type="checkbox"/>            | four months           | \$ 1,480.00                        | \$ 740.00               |

Fee: \$950.00

If an additional extension of time is required, please consider this a petition therefor.

*(check and complete the next item, if applicable)*

- ☐ An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

**OR**

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

Docket No. 45858/55672  
APPLICANT: Goldsborough, et al  
SERIAL NO. 09/725,897  
FILED: November 30, 2000

**FEE FOR CLAIMS**

4. The fee for claims (37 C.F.R. Section 1.16(b)-(d)) has been calculated as shown below

| (Col.1)                                         | (Col. 2)                        | SMALL ENTITY  |          |            | OR | OTHER THAN A SMALL ENTITY |               |
|-------------------------------------------------|---------------------------------|---------------|----------|------------|----|---------------------------|---------------|
| Claims Remaining After Amendment                | Highest No. Previously Paid For | Present Extra | Rate     | Addit. Fee |    | Rate                      | Addit. Fee    |
| 16                                              | 16                              | 0             | \$9.00   | \$         |    | \$18.00                   | \$ .00        |
| Independent Claims                              |                                 | 0             | \$43.00  | \$         |    | \$86.00                   | .00           |
| First Presentation of Multiple Dependent Claim+ |                                 |               | \$145.00 | \$         |    | \$290.00                  | \$ .00        |
|                                                 |                                 |               |          |            |    | <b>Total Addit. Fee</b>   | <b>\$ .00</b> |

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "O" in Col. 3,  
\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, enter "20".  
\*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, enter "3".  
The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

**WARNING:** *"After final rejection or action (Section 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made." 37 C.F.R. Section 1.116(a) (emphasis added).*

*(complete (c) or (d), as applicable)*

- (c) ☒ No additional fee for claims is required.

**OR**

- (d) ☐ Total additional fee for claims required \$ 00

**FEE PAYMENT**

5. ☒ Attached are checks in the sum of \$ 950.00 (extension fee) and \$ 770.00 (RCE fee).  
☐ Charge Account No. \_\_\_\_\_ the sum of \$ \_\_\_\_\_.

Docket No. 45858/55672  
APPLICANT: Goldsborough, et al  
SERIAL NO. 09/725,897  
FILED: November 30, 2000

A duplicate of this transmittal is attached.

**FEE DEFICIENCY**

*NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, (1065 O.G. 31-33).*

6. ☒ If any additional extension and/or fee is required, charge Account No. 04-1105.

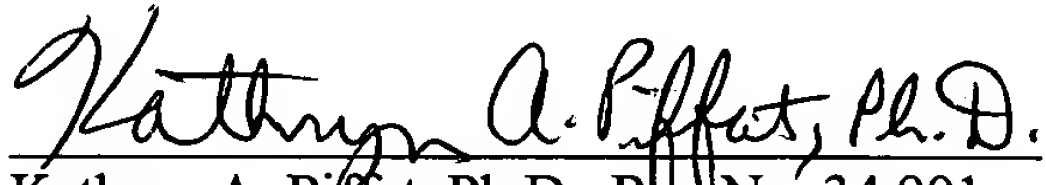
**AND/OR**

- ☒ If any additional fee for claims is required, charge Account No. 04-1105.

Respectfully submitted,

Date: April 30, 2004

Customer No.: 21874

  
Kathryn A. Piffat, Ph.D., Reg No. 34,901  
Intellectual Property Practice Group of  
Edwards & Angell, LLP  
P.O. Box 55874  
Boston, MA 02205  
Tel.: 617.439.4444

BOS2\_443055.1